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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,676	04/15/2004	William T. Rochford	82523APAL	8144

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EXAMINER

DOERRLER, WILLIAM CHARLES

ART UNIT	PAPER NUMBER
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3744

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,676

Applicant(s)

ROCHFORD ET AL.

Examiner

William C Doerfler

Art Unit

3744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8-14,16,17,19,20,22,23,25 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8-14,16,17,19,20,22,23,25 and 32-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 depends from cancelled claim 18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,8-13,14,16,17,19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '119 Japanese patent in view of Imaeda.

The '119 Japanese patent discloses a label 1 with an overcoat layer containing beads which will impart a tactile feature to the label. The abstract contains the desired size of the particles. The '119 Japanese patent does not state that the adhesive is pressure sensitive, forming Braille characters and only adding tactile features to a portion of the label. Imaeda shows these features to be old in the tactile feature printing art, with the mention of pressure sensitive adhesive in line 44 of column 3. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Imaeda to modify the label of the '119 Japanese reference by using a pressure sensitive adhesive for ease of application, and only texturing a portion of the label, such as using Braille characters to enable information to be conveyed, such as to visually impaired people. In regard to claim 16, forming a pattern in the textured surface is considered a matter of obvious design choice.

Claims 25,32 and 33 are rejected under 35 U.S.C. 103a) as being unpatentable over Bohan et al in view of Imaeda.

Bohan et al disclose an image with an overcoat which can contain particles "which will impart surface roughness to the overcoat" (column 6 lines 48-49). The last lines of column 5 state that the overcoat can be formed from vinyl polymers. Line 7 of column 6 states that urethane polymers can be used. Given that the thickness (column 5 lines 39-40) is the same as currently claimed, The indentation modulus of claim 33 is seen as inherent since the coating is made of claimed materials at the claimed thickness. . Bohan does not state the use of adhesive which is pressure sensitive. Imaeda shows this feature to be old in the tactile feature printing art in line 44 of column 3. It would

have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Imaeda to modify the label of Bohan by using a pressure sensitive adhesive for ease of application.

Claims 1,8,10,11,12,13,21,22,31,34,37,38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohan et al in view of Imaeda.

Bohan et al disclose applicants' basic inventive concept, a image formed using silver halide with an overcoat that imparts tactile features to the image, substantially as claimed with the exception of using the image as a pressure sensitive adhesive label. Imaeda shows this feature to be old in the tactile image art. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Imaeda to modify the tactile image of Bohan et al by using it as a pressure sensitive adhesive label to permit the image to be easily adhesively attached to a surface. In regard to claim 34, Official Notice is taken that gravure printing is well known in the printing art and as such would have been obvious to one of ordinary skill in the art to provide an economically reproduced image. In regard to claim 37 Official Notice is taken that thermal dye is well known in the printing art and would have been obvious to provide an image that is quickly produced. In regard to claim 38, Official Notice is taken that fiduciary marks are common on labels such as the one shown in the Japanese patent and as such, such marks would have been obvious to an ordinary practitioner in the art to convey information to the consumer.

Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohan et al in view of Imaeda as applied to claims 25,32 and 33 above and further in view of Sokyrrka.

Bohan, as modified, discloses applicants' basic inventive concept, an image with tactile features from particles in an overcoat, substantially as claimed with the exception of forming the layer using a primer and a UV cured outer layer and forming the overcoat layer as discontinuous. Sokyrrka shows these features to be old in the printing art. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Sokyrrka to modify the label of Bohan et al by forming the overcoat using a primer and a UV cured compound to produce tactile features quickly allowing for mass production and to provide a discontinuous outer layer to provide extended tactile features which can be felt more easily.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese '119 patent in view of Imaeda as applied to claims 1,8-13,14,16,17,19 and 25 above and further in view of Yamada.

The '119 Japanese patent, as modified, discloses applicants' basic inventive concept, a label with tactile features from particles in an overcoat, substantially as claimed with the exception of forming the outer layer from gelatin. Yamada shows this feature to be old in the printing art. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Yamada to modify the label of the Japanese reference by forming the outer layer from a gelatin to protect the label.

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-14 and 52 of U.S. Patent No. 6,755,350. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim labels with both tactile and olfactory features. It is considered obvious that a label having olfactory features with added tactile features is the same as a label having tactile features with added olfactory features. The features that were added to the label of the previous application during prosecution make the current claim 20 broader than the patented claims. It is considered obvious to one of ordinary skill in the art that the indentation modulus need not be that claimed to derive a label having both olfactory and tactile features.

Response to Arguments

Applicant's arguments with respect to claims 1,8-14,16,17,19,20,22,23,25 and 32-39 have been considered but are moot in view of the new ground(s) of rejection.

Most of applicants' remarks are directed to the lack of pressure sensitive adhesive. Imaeda is now relied upon to show this feature to be old in the tactile feature printing art. It is unclear why applicant states that claim 8 is not shown by the cited references when it is stated on page 7 of the amendment that, "Bohan et al and the '119 Japanese reference disclose surface roughness created by inorganic particles in the overcoat layer." That is what is being claimed in claim 8. The fact that the roughness may be reduced due to methods used does not mean that the surface roughness, and thus the tactile feature will not still be present. In regard to claim 19, having Braille in one part and an image in another part of a label is seen as the tactile feature being in a complimentary portion of the image.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C Doerrler whose telephone number is (571) 272-4807. The examiner can normally be reached on Monday-Friday 6:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on (571) 272-4808. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William C Doerrler
Primary Examiner
Art Unit 3744

WCD